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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/346,910	11/30/94	LIPTON	S 00108017004
			EXAMINER

HM12/0301

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GOVERNMENT	PAPER NUMBER
1645	19

DATE MAILED: 03/01/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 11/19/98
- ☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

- ☒ Claim(s) 2-10 is/are pending in the application.
- Of the above, claim(s) 2-7 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 8-10 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

BEST AVAILABLE COPY

Art Unit: 1646

*Response to Amendment*

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1646.
2. Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's second submission after final filed on 3/8/00 has been entered.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Any objections or rejections made in a previous Office Action that are not herein reinstated have been withdrawn.
5. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant specification describes the purification of partial nucleic acids encoding partial amino acid sequences of a single protein species, protein 68075 or human MEF2C, from a single animal species, human. The specification therefore has a single embodiment that has been shown to work as a transcription factor *in vitro*. It does not adequately describe, give examples, or provide guidance on the purification of fragments of nucleic acid that would encode functional

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fragments of transcription factors because the specification is silent as to what are the critical encoded amino acid domains that bestow upon the encoded transcription factor its desired and recited biological properties of promoting regeneration. Although the deposited clones are only partial sequences, they meet the utility and written description guidelines because they have been described as capable of being used to isolate the full length sequence of what is now known as human MEF2C which the specification correctly describes as being useful for promoting process generation of neurons. However, fragments of the nucleic acid are not enabled because the vast majority of said fragments, if any, would not possess the recited limitation of encoding a functional domain of the protein because it is very likely that none of the deposited clones (which are small partial sequences) possess this recited limitation themselves because they are too small when compared to the full length of the encoded MEF2C transcription factor.

6. Claims 8 and 11-12 are in condition for allowance.

7. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Gucker whose telephone number is (703) 308-6571. The examiner can normally be reached on Monday to Friday from 0830 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on

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(703) 308-4623. The fax phone number for this Group is currently (703) 308-4242, but Applicant should confirm this by phoning the Examiner before faxing.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SG

Stephen Gucker

May 22, 2000

*Gary L. Kunz*  
GARY L. KUNZ  
PRIMARY EXAMINER  
GROUP 1200